

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL DAMIAN NELSON

Appeal No. 2001-0206
Application 08/959,964

ON BRIEF

Before STAAB, MCQUADE, and NASE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Paul Damian Nelson originally took this appeal from the final rejection of claims 1 through 7, 10, 12, 18, 20, 22, 24 through 26, 32 and 33. As the appellant has since canceled claim 26, the appeal now involves only claims 1 through 7, 10, 12, 18, 20, 22, 24, 25, 32 and 33, all of the claims currently pending in the application.

THE INVENTION

The invention relates to "a bicycle seat for high performance bicycle riding, such as time trialing and other

bicycle racing" (specification, page 1). Representative claim 1 reads as follows:

1. A cycle seat for a bicycle, including:
an inclined surface forming abutment means for receiving a portion of a rider's anatomy which is adjacent at least one of the rider's ischial bones, the abutment means being dimensioned to receive only the portion of the rider's anatomy adjacent the ischial bone(s) so that the rider's soft tissue or muscle substantially outside the ischial bone(s) is not compressed or squeezed by the seat when the rider is on the seat; and
support means coupled to said abutment means for supporting the abutment means and for coupling the seat to the bicycle so that the abutment means is permanently transverse with respect to the longitudinal axis of the bicycle when the support means couples the seat to the bicycle so that without other support, it is not possible to permanently sit on the inclined surface with the backbone of the rider arranged generally vertically.

THE PRIOR ART

The references relied on by the examiner as evidence of anticipation are:

Martin	4,108,462	Aug. 22,
1978		
Barker et al. (Barker)	4,387,925	Jun. 14,
1983		

THE REJECTIONS

Claims 1 through 7, 10, 12, 18, 20, 22, 24, 25, 32 and 33 stand rejected under 35 U.S.C. § 112, second paragraph, as

failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 1 through 7, 10, 12, 18, 20, 22, 24, 25, 32 and 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Barker.

Claims 32 and 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Martin.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 17 and 20) and to the examiner's answer (Paper No. 19) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.¹

DISCUSSION

I. The 35 U.S.C. § 112, second paragraph, rejection

The explanation of this rejection (see pages 3, 4, 6 and 7 in the answer) indicates that the examiner considers claims

¹ Since the examiner (see the advisory action dated February 14, 2000, Paper No. 23) has vacated the supplemental answer mailed August 10, 1999 (Paper No. 21), we have not considered the arguments advanced therein in deciding the appeal.

1 through 7, 10, 12, 18, 20, 22, 24, 25, 32 and 33 to be indefinite because they include numerous functional or operational limitations which define a bicycle seat relative to the anatomy of the user which, in the examiner's view, constitutes a non-claimed variable standard.

The examiner's position here is not well founded.

There is nothing intrinsically wrong with using functional (or operational) language in a claim to define something by what it does rather than by what it is. In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Swinehart, 439 F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971). Thus, the mere fact that the appellant's claims contain functional or operational language which defines the bicycle seat in terms of the anatomy of a user does not render the claims indefinite.

The examiner's observation that the anatomy of a user, at least to the extent recited in the appealed claims, may vary from person to person is well taken and is acknowledged by the appellant (see, for example, page 9 in the specification). As for the definiteness issue raised by this circumstance, the

second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. Thus, depending on the facts involved, claims that refer to a standard that is variable may or may not be definite. Compare, for example, Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986) and Ex parte Brummer, 12 USPQ2d 1653 (Bd. Pat. App. & Int. 1989)). The disclosure in the instant application indicates that the inventive essence of the appellant's bicycle seat lies in its relationship to certain parts of a user's anatomy, with clear distinctions being drawn between such relationship and those embodied by prior art bicycle seats. Thus, the appellant's claims would appear to be as accurate as the

particular subject matter permits. In this light, they do set out and circumscribe the subject matter with a reasonable degree of precision and particularity.

Therefore, we shall not sustain the standing 35 U.S.C.

§ 112, second paragraph, rejection of claims 1 through 7, 10, 12, 18, 20, 22, 24, 25, 32 and 33.

II. The 35 U.S.C. § 102(b) rejection based on Barker

Barker discloses a bicycle seat 9 comprising two support portions 10 and 11 "shaped to conform generally to the human anatomy in the buttock and upper leg region" (column 2, lines 35 through 37). A horizontal mounting member 15, which is affixed to the bicycle via a frame 16 and a clamp 31, carries the support portions 10 and 11 at selected lateral positions with a limited degree of free rotation (see Figure 3) that enables unobstructed pedaling motion. As for the specific shape of the support portions, Barker teaches that

[t]he surface configuration is of particular importance to this invention in that the shape has been derived so that the weight of the rider is distributed uniformly over the entire surface of support portions 10 and 11. This particular shape eliminates any high pressure points which could cause either long or short term rider discomfort. Thus, the bicycle seat not only eliminates undue

pressure to the sub scrotal area by providing two split support portions but, by providing the particular and critical shape of the surface area of the support portions 10 and 11, eliminates any other areas of high pressure which could cause discomfort.

The typical single support surface bicycle seat in use today provides approximately 27 square inches of support surface for the rider. My improved bicycle seat preferably provides approximately 22 square inches of support per each support portion 10 and 11, for a total of 44 square inches of support. However, this fact alone will not, in itself, provide the increased comfort desired. In order to make efficient use of the increased support area the surface must be shaped so that the weight of the rider is uniformly distributed over the entire surface. For maximum comfort the ratio between the highest pressure and the lowest pressure should be as small as possible.

In order to obtain the proper surface shape for support portions 10 and 11 it is necessary to conform the shapes as much as possible to the shape of the human skeleton in the region of the ischium and upper femur, the bones which are actually supported by the seat [column 3, lines 33 through 62].

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Although independent claims 1, 2, 10, 18, 20, 22, 32 and 33 vary in scope, they all in effect require a bicycle seat

having an abutment surface or means which receives or is dimensioned to receive or support only the portion of a rider's anatomy adjacent the ischial bones while not engaging, compressing and/or squeezing any surrounding tissue or muscle. Barker does not expressly disclose such a seat. The examiner's apparent position that Barker's seat is inherently capable of functioning in accordance with the claims is unduly speculative and, in any event, is not on point. Although the claim limitations at issue are cast in functional or operational terms, they nonetheless define the structure, e.g., the dimensions, of the seat. Barker simply does not disclose such a seat, either expressly or under principles of inherency. Indeed, Barker's teaching that the seat disclosed therein provides a support area which is much larger and more uniformly weight-bearing than the typical bicycle seat is inconsonant with the above noted limitations in the appellant's claims.

Thus, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 1, 2, 10, 18, 20, 22,

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32 and 33 and dependent claims 3 through 7, 12, 24 and 25 as being anticipated by Barker.

III. The 35 U.S.C. § 102(b) rejection based on Martin

Martin discloses an adjustably-mounted bicycle seat 40 comprising a rectangular base 42, padding 44 and a covering 46. In short, Martin's disclosure of this seat suffers the same deficiencies with respect to the limitations in claims 32 and 33 as does Barker's disclosure.

Accordingly, we shall not sustain the standing 35 U.S.C.

§ 102(b) rejection of claims 32 and 33 as being anticipated by Martin.

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SUMMARY

Since none of the examiner's rejections is sustained, the decision of the examiner to reject claims 1 through 7, 10, 12, 18, 20, 22, 24, 25, 32 and 33 is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
)	
)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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JPM/kis
PRICE, HENEVELD, COOPER
DEWITT & LITTON
P. O. BOX 2567
GRAND RAPIDS, MI 49501